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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,674	02/11/2004	Rudolf Faust	ULI-002	3484
959	7590	03/03/2006	EXAMINER TESKIN, FRED M	
LAHIVE & COCKFIELD 28 STATE STREET BOSTON, MA 02109			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Claims 1-36 are currently pending herein.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-31, drawn to a copolymer, classified in class 526, subclass 313.
- II. Claims 32-36, drawn to a method of making a block copolymer, classified in class 525, subclass 192+.

The inventions are distinct, each from the other because:

Inventions of Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case one would expect that the copolymer product as claimed can be made by another and materially different process; e.g., by the procedure of Kanagawa et al (note Example 4) or by subjecting a *preformed* polymer of (un)protected hydroxystyrene monomer and a capped polyolefin block to a coupling reaction, or by chemically aftertreating an olefin/styrene block copolymer to introduce phenolic functionality.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, with the

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search required for Group II not being required for Group I, restriction for examination purposes as indicated is proper.

In the event applicants elect the invention of Group I for examination on the merits, the following election requirement applies.

Claims 1-10 are generic to the following disclosed patentably distinct species: (i) random or statistical copolymer; (ii) alternating copolymer; and (iii) block copolymer. The species are considered independent or distinct because they are not so closely related, chemically and structurally, that a prior art reference anticipating the claims with respect to one of the species would render the claims obvious (35 U.S.C. 103) with respect to the other species. Applicants are required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement may be traversed. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicants must indicate which are readable upon the elected species.

MPEP § 809.02(a).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. **Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined.** See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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PRIMARY EXAMINER
1713

FMTeskin/02-26-06